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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|-----------------------|------------------|
| 09/918,130 | 07/30/2001 | Robert O. Bruckner | INTL-0645-US (P12309) | 1396 |

7590 09/27/2004

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EXAMINER

CHEN, TSE W

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2116

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------|--------------------------------------|--|--|
| Advisory Action | Application No. 09/918,130 | Applicant(s) BRUCKNER ET AL. | |
| | Examiner Tse Chen | Art Unit 2116 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

**REHANA PERVEEN
PRIMARY EXAMINER**

9/16/04

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments with respect to claims 1, 18, 17, and 23 have been fully considered but they are not persuasive.

In re claim 1, Applicant alleges that "Baron does not teach or suggest all of the claim limitations that are missing from Hussain". Applicant supported the allegation by stating that "Baron does not teach or suggest powering down a processor independently from the PSWITCHW signal and powering down other components in response to the PSWITCHW signal" and concludes that "neither Hussain nor Baron teaches or suggests the controlling and powering down acts that are recited in claim1" and that "there is no teaching or suggestion in Baron relating to using the PSWITCHW signal for purposes of control and shut-down in the case of a thermal event." Woefully missing from Applicant's allegation is what Hussain does teach or suggest as discussed in part 6 of the previous Office Action. Applicant is invited to review the rejection of claim 1 in the previous Office Action and be reminded that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Applicant continues with the allegation that "the Examiner fails to show where the prior art contains the alleged suggestion or motivation to combine Baron and Hussain to derive the claimed invention." Again, Applicant is invited to review the rejection of claim 1 in the previous Office Action and note the motivation cited in part 9. The Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Hussain provides the motivation by indicating the need to develop ACPI for thermal management [col.1, ll.37-56]. Since Hussain provides the details regarding thermal management and Baron provides the details regarding ACPI, one with ordinary skill in the art, having the teachings of Hussain and Baron before him at the time the invention was made, would have combined the teachings due to the cited motivation.

In re claim 7, Applicant alleges that "neither Hussain nor Baron specifies a different power down sequence for a processor than for other power consuming components." Woefully missing is any support of the allegation as Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant continues with the allegation that "the Examiner has failed to show the existence of the alleged suggestion or motivation to combine Baron and Hussain to derive the claimed invention." Applicant is invited to review the rejection of claim 7 in the previous Office Action, note the motivation cited in part 15, and refer to the previous discussion in claim 1.

In re claim 18, regarding Applicant's argument that "Howard does not address or even contemplate a thermal event occurring" and "thus, there is no suggestion or motivation present in Howard or Hussain to modify Hussain so that Hussain's system powers down the same way in response to a thermal event as Howard's system enters a power conservation state", the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Applicant is invited to review the rejection of claim 18 in the previous Office Action and note the motivation cited in part 18. In this case, Howard provides the motivation by indicating the advantage of efficiently powering down a computer system in a controlled sequence [col.2, l.56 - col.3, l.4; improved power management with a proper sequencing of shutdown operations]. Since Hussain discloses a general shutdown without the details of a powering down sequence and Howard discloses the details of a powering down sequence, one with ordinary skill in the art, having the teachings of Hussain and Howard before him at the time the invention was made, would have combined the teachings due to the motivation to improve power management with a controlled powering down sequence.

In re claim 23, Applicant alleges that "the Examiner has failed to show where the alleged suggestion or motivation exists to modify Hussain's thermal event power down sequence in view of Howard's power conservation mode transition sequence to derive the claimed invention." Applicant is invited to review the rejection of claim 23 in the previous Office Action, note the motivation cited in part 34, and refer to the previous discussion in claim 18.